

REMARKS

At the time of the Third Office Action dated February 6, 2008, claims 1-24 and 33-35 were pending and rejected in this application.

**CLAIMS 1-24 AND 33-35 ARE REJECTED UNDER 35 U.S.C. § 102 FOR ANTICIPATION
BASED UPON YOAKUM ET AL., U.S. PATENT PUBLICATION NO. 2004/0059781 (HEREINAFTER
YOAKUM)**

On pages 2-6 of the Second Office Action, the Examiner asserted that Yoakum identically discloses the claimed invention the claimed invention. This rejection is respectfully traversed.

The factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure, either explicitly or inherently, of each element of a claimed invention in a single reference.¹ Moreover, the anticipating prior art reference must describe the recited invention with sufficient clarity and detail to establish that the claimed limitations existed in the prior art and that such existence would be recognized by one having ordinary skill in the art.² As part of this analysis, the Examiner must (a) identify the elements of the claims, (b) determine the meaning of the elements in light of the specification and prosecution history, and (c) identify

¹ In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); Perkin-Elmer Corp. v. Computervision Corp., 732 F.2d 888, 894, 221 USPQ 669, 673 (Fed. Cir. 1984).

² See In re Spada, 911 F.2d 705, 708, 15 USPQ 1655, 1657 (Fed. Cir. 1990); Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 678, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988).

corresponding elements disclosed in the allegedly anticipating reference.³ This burden has not been met.

Each of independent claims 1, 9, 17, and 33 recite that the telephone has a connection with a packet-switched network. However, Fig. 1 of Yoakum clearly illustrates that the telephone 16A, 16B is connected to a circuit-switched network 10 and not the packet-switched network 12. Thus, Yoakum fails to identically disclose the claimed invention within the meaning of 35 U.S.C. § 102. Moreover, Applicants note that claims 1 and 33 are directed to telephones. However, many of the features within Yoakum referred to by the Examiner in the statement of the rejection are not found within a telephone. Thus, these claims further distinguish the claimed invention over Yoakum.

Therefore, for the reasons stated above, Applicants respectfully submit that the imposed rejection of claims 1-24 and 33-35 under 35 U.S.C. § 102 for anticipation based upon Yoakum is not viable, and hence, Applicants solicit withdrawal thereof.

³ Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

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